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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,070	09/30/2003	Frank Molock	VTN 5013	5103
27777	7590	09/01/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			SASTRI, SATYA B	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/675,070

Applicant(s)

MOLOCK, FRANK

Examiner

Satya B. Sastri

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/6/05, 5/20/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This office action is in response to application filed on September 30, 2003. *Claims 1-16* are now pending in the application.

#### *Claim Rejections - 35 USC § 102 and 103*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. *Claims 1, 5-10, 12-15* are rejected under 35 U.S.C. 102(b) as anticipated by Vanderlann et al. (WO 02/062402 A1).

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Prior art to Vanderlaan et al. discloses a method of preparing soft contact lenses from a composition comprising 40.67 weight % 2-hydroethyl methacrylate 1.07% tetraethyleneglycol dimethacrylate, 26.9% glycerin 1-monomethacrylate and 30.36% poly(ethylene glycolmethyl ether (mPEG 350 as diluent) in working examples 6-8 (page 12). Thus, *claims 1, 5-10, 12-15* are anticipated by the prior art.

5. *Claims 1, 5-10, 12-14* are rejected under 35 U.S.C. 102(e) as anticipated by Marmo (US2004/0214914 A1).

Prior art to Marmo discloses soft contact lenses based on hydrogels. The polymeric material is obtained by polymerizing at least one hydrophilic monomeric component selected from hydroxyalkyl (meth)acrylates, N-vinyl pyrrolidone, acrylamides etc., with at least one cross-linking agent (pages 1-2, paragraphs 0015, 0016). Hydrophilic monomeric components may include polyalkoxy-alkyl mono or bicycloaliphatic fumarates, maleates, acrylates etc. (page 2, paragraph 0020). The crosslinking monomers may include di(meth)acrylates, tri(meth)acrylates, end capped polyoxyethylene polyols containing two or more terminal methacrylate moieties etc. (page 3, paragraph 0047). A polymerization catalyst may be included in the monomer mixture for polymerization by solution in the presence of a diluent material (page 4, paragraphs 0049-0050). Working example 5 on page 5 discloses a method of preparing a hydrogel-containing contact lens from 48.8% by wt. of 2-hydroxy methacrylate, 0.5% by weight of methacrylic acid, 0.7% by weight of a crosslinking agent and 50% by weight of methyl terminated polyethylene glycol having a molecular weight of 350 (PEGME-350). Thus, the instant claims are anticipated by the prior art.

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6. *Claims 2-4, 16* are rejected under 35 U.S.C. 103(a) as being unpatentable over either Vanderlann et al. (WO 02/062402 A1) or Marmo (US2004/0214914 A1) in view of Wichterle (US 4,534,916 A).

Prior art to Vanderlann et al. and Marmo are disclosed above in paragraphs 5 and 6, respectively, and incorporated herein by reference.

The difference between the prior art and the instant invention is that the prior art does not disclose the use of a second diluent in the method of making ophthalmic devices.

The secondary reference to Wichterle discloses the use of a variety of solvents for polymerization reaction (xx). Disclosed solvents include water, organic solvents such as alcohols, polyhydric alcohols etc. and mixtures thereof, in amounts less than 50% by weight of the reaction mixture (column 5, lines 4-13). Thus, the use of one or more solvents in polymerization mixtures is disclosed by the secondary reference and is well within the capabilities of ordinary skill in the art. Given this teaching, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a second solvent in the polymerization mixtures as disclosed by Vanderlann or Marmo and thereby obtain the instant invention.

With regard to *claim 16*, it is the examiner's position that the use of tetrapropylene glycol as a solvent is obvious in light of the generic teaching of polyhydric alcohols as a solvent, absent a showing of criticality.

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7. *Claim 11 is* are rejected under 35 U.S.C. 103(a) as being unpatentable over either Vanderlann et al. (WO 02/062402 A1) or Marmo (US2004/0214914 A1) in view of Kunzler et al. (US 5,006,622).

Prior art to Vanderlann et al. and Marmo are disclosed above in paragraphs 5 and 6, respectively, and incorporated herein by reference.

The difference between the prior art and the instant invention is that the prior art does not disclose the use of a hydrophobic monomer along with a hydrophilic monomer in the method of making ophthalmic devices.

The secondary reference to Kunzler et al. discloses the use of hydrophobic monomers with hydrophilic monomers for the preparation of hydrogel materials for contact lenses. Such a combination results in hydrogel materials with substantial hydrophilic character, substantially greater mechanical strength than the state of the art hydrogel materials (column 2, lines 9-14). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include one or more hydrophobic monomers with hydrophilic monomers in polymerization mixtures disclosed by Vanderlann or Marmo and thereby obtain the instant invention.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satya Sastri at (571) 272 1112.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached at (571) 272 1114.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SATYA SASTRI

August 18, 2005



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